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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,789	03/13/2000	Karim Asani	99951.1	6310

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EXAMINER

WASYLCHAK, STEVEN R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant No.

09/523,789

Applicant(s)

ASANI, KARIM

Examiner

Steven R. Wasylchak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/8/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-12 are pending.
2. On page 8, item 3, of the response dated Feb. 8, 2004, the word "intercooperate" does not exist in the English language. Should the case go forward to Appeal, examiner requests that the disclosure be read very carefully for errors in grammar, as in "...much needed to secure ..." in the disclosure.
3. While a time line *per se* has not been presented as requested, examiner has a much grasp of the claims with the new flowchart and such request is in abeyance.
4. Examiner notes that a pin number, a term omitted throughout the disclosure, is equivalent to "password". Examiner has considered Applicant's argument's and respectfully finds them unpersuasive. In essence, Examiner has come to the conclusion that the Applicant has, in effect, devised a method of internet shopping using a portable I/O device such as a client dedicated smart card that acts as a portable ATM attached to a personal computer. From the point of view of portability, *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952), states that portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results.
5. The prior office action rejection is given for Applicant's convenience.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kolling et al (US 5,920,847).

As per claim 1,

A data processing system for executing an e-financial transaction in an account having at least one customer specified secure parameter, comprising:

-a central controller including a CPU and a memory operatively connected

to said CPU;/ col 2, L 54 to col 3, L 4

-at least one terminal, adapted for communicating with said central controller, by

transmitting the secure parameter to said central controller; / col 2, L 54 to col 3, L

4(inherently an ATM has a terminal and one uses an id or pin number as a secure

parameter and a bank account number is also a secure parameter and "sent" on line 61

is equivalent to transmit)

-said memory in said central controller containing a program, adapted to be executed by

said CPU, for executing e-financial transactions for the secure parameter, wherein the

secure parameter is a password or code / col 2, L 54 to col 3, L 4(inherently an ATM

has a terminal and one uses an id or pin number as a secure parameter and a bank

account number is also a secure parameter or code); col 11, L 34-49; col 12, L 60 to col

13, L 9; col 24, L 66 to col 25, L 12; fig 11: col 25, L 57- col 26, L 24; fig 6; col 38, L1-5

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wherein said central controller receives the secure parameter from said terminal and executes the e-financial transaction for the account based upon the secure parameter, without requiring access to personal financial, banking, or credit card information./ col 2, L 54 to col 3, L 4 (inherently an ATM has a terminal and one uses an id or pin number as a secure parameter and a bank account number is also a secure parameter or code); col 12, L 29-47; col 28, L 32 to col 29, L 2; **fig 19B: Examiner states that this separation limitation appears to be at the core of applicant's invention and is traversed by fig 19B where there is no personal financial information link between the consumer's I/O device and the merchant (biller) *during* the execution of this transaction because there is no link or directional arrow between the consumer and the biller merchant during the transaction.**

As per claim 2,

The system according to claim 1, wherein the terminal comprises an input/output device, wherein the terminal is further adapted to transmit customer information to said controller, and said program in said memory executes the financial transaction in the account having the secure parameter based upon the customer information./ abstract; col 11, L 14-46, col 12, L 20-28(input/output)

As per claim 3,

The system according to claim 2, wherein the customer information comprises an account identifier that specifies a pre-existing bank account, and said secure parameter comprises a password./ col 11, L 14-33(BRN, protocols); col 12, L 20-27 (inherently the ATM uses a password or pin #)

As per claim 4,

The system according to claim 1, wherein said program in said memory is adapted to receive a customer acceptance via said terminal to enter into an account having the secure parameter and charge the customer the calculated amount of funds by debiting the customer's account and transferring the funds to a bank account specified by the customer./ col 2, L 54-67; col 9, L 53-57; col 12, L 14-31

As per claim 5,

The system according to claim 2, wherein the input/output device comprises an electronic vault, a microcomputer chip or a smart card./ col 11, L 46-49 (inherently an ATM is equivalent to an electronic vault); col 11, L 46-49; col 12, L 24-28(microcomputer chip exists in the PDA)

As per claim 6,

The system according to claim 3, wherein the password is transferred using an encryption technology./ col 15, L 36-46; fig 5; col 17, L 57 to col 18, L 22

As per claim 7,

A method of executing an e-financial transaction having at least one customer specified secure parameter using a central controller including a CPU and a memory operatively connected to said CPU and containing a program adapted to be executed by said CPU for calculating the amount of funds, and a terminal adapted for communicating with said central controller, the method comprising the steps of:

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-transferring a specified amount of funds to the central controller through an electronic fund transfer or cash, receiving an input/output device and a secure password from the central controller, executing the e-financial transaction by inputting the secure password and bank information to the central controller via the terminal;

processing a program to execute the e-financial transaction transmitted by the secure password, the amount of funds having the password security; and outputting the calculated funds from the controller to a bank account specified by the customer./ col 2, L 54 to col 3, L 4(inherently an ATM has a terminal, CPU to calculate amount of funds and one uses an id as a secure parameter and a bank account number is also a secure parameter and "sent" on line 61 is equivalent to transmit)

col 11, L 34-49; col 12, L 60 to col 13, L 9; col 24, L 66 to col 25, L 12;

col 12, L 29-47; abstract; col 11, L 14-46, col 12, L 20-28(input/output);

col 11, L 14-33; col 12, L 20-27(inherently the ATM uses a password) fig 11: col 25, L 57- col 26, L 24; fig 6; col 38, L1-5

As per claim 8,

The method according to claim 7, further comprising the step of inputting customer information to the controller via the terminal, and wherein the step processing the program further comprises calculating the amount of funds based on the customer information./ col 11, L 14-25, 50-56

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As per claim 9,

The method according to claim 7, wherein the step of inputting the customer information further comprises inputting an account identifier that specifies a preexisting bank account./ col 11, L 14-33; col 12, L 20-27

As per claim 10,

A data processing system for executing an e-financial transaction having at least one customer specified secret password, comprising:

- a CPU; a memory operatively connected to said CPU, said memory containing a program, adapted to be executed by said CPU, for receiving the secret parameter and calculating the amount of funds having the secret password; and input/output device, operatively connected to at least one of said memory and said CPU, for input of the secret password and for output of the funds./ col 2, L 54 to col 3, L 4(inherently an ATM has a terminal, CPU to calculate amount of funds and one uses an id as a secure parameter and a bank account number is also a secure parameter and "sent" on line 61 is equivalent to transmit)

col 11, L 34-49; col 12, L 60 to col 13, L 9; col 24, L 66 to col 25, L 12;

col 12, L 29-47; abstract; col 11, L 14-46; col 12, L 20-28(input/output);

col 11, L 14-33; col 12, L 20-27(inherently the ATM uses a password);

col 11, L 50-56; fig 11: col 25, L 57- col 26, L 24; fig 6; col 38, L1-5

As per claim 11,

A method of executing an e-financial transaction having at least one customer specified secret password using a CPU and a memory operatively connected to said CPU and

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containing a program, adapted to be executed by said CPU, for calculating a price, the method comprising the steps of:

-receiving the secret password; executing the program in the CPU for calculating; the amount of funds having the secret password; and outputting the funds. / col 2, L 54 to col 3, L 4(inherently an ATM has a terminal, CPU to calculate funds and one uses an id as a secret password; col 11, L 34-49; col 12, L 60 to col 13, L 9; col 24, L 66 to col 25, L 12; col 12, L 29-47; abstract; col 11, L 14-46, col 12, L 20-28(input/output) col 11, L 14-33; col 12, L 20-27; col 11, L 50-56

As per claim 12,

Computer executable process steps, stored on a computer readable medium, for executing an e-financial transaction having at least one customer specified secret password, comprising:

-a step to receive the secret password; a step to calculate the amount of funds having the password;/ col 2, L 54 to col 3, L 4(inherently an ATM has a terminal, CPU to calculate funds and one uses an id as a secret password; col 11, L 34-49; col 12, L 60 to col 13, L 9; col 24, L 66 to col 25, L 12; col 12, L 29-47; abstract; col 11, L 14-46
-and a step to output the funds./ col 12, L 24-28

This action is FINAL. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R. Wasylchak whose telephone number is (703) 308-2848. The examiner can normally be reached on Monday-Thursday from 8:00 a.m. to 6:00 p.m. EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1065. The fax number for Art Unit 3624 is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Steven Wasylchak

4/27/04



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